

### **Remarks/Arguments**

Claims 1, 3 and 4 are pending. Independent Claim 1 has been amended by inserting the content of dependent Claim 2. Claim 1 now recites that the filter is hydrophilic - support is from cancelled Claim 2.

Claim 1 was also amended to recite that “the negative pressure is caused by the memory which expands the inner layer in a manner wherein a difference between an inner negative pressure and an ambient air is higher than a liquid filtration resistance of the filter and lower than an air filtration resistance of the filter wetted” – the added new language is supported by page 3, line 21, to page 4, line 2, of the specification.

A new IDS (art statement), a new Form PTO-1499, and a copy of the two references has been filed with the RCE and this supporting amendment.

Please note that the original application contains five headings that identify the parts of the application.

The Office Action stated that the following is a quotation of 35 U.S.C. 103(a) which forms the basis for the obviousness rejection set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 4 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0130139 to Shiraishi et al. (Shiraishi) in view of U.S. Patent 5,497,910 to Meadows et al. (Meadows). Applicants traverse this rejection.

The content of dependent Claim 2, plus other limitation has been inserted into independent Claim 1. Applicants believe that amended independent Claim 1 is unobvious over the rejection combination of Shiraishi et al. and Meadows et al. This matter is discussed in detail below.

The Office Action stated that, in reference to Claim 1, Shiraishi et al. teaches:

A discharging container with a filter (1) comprising:

a bottle (2) which is formed in a manner wherein an inner layer (22) peelable from an outer layer (21) is formed on an inner surface of the outer layer;

a plug body (3) placed on a mouth portion (2a) of the bottle; and

a filter provided (7) in a discharging pass (10) which is provided in the plug body for discharging liquid kept in a body of the inner layer.

The Office Action stated that Shiraishi et al. further teaches:

a dispensing valve (8) has a memory which expands the valve in a manner wherein the difference between an inner negative pressure and

an ambient air is higher than a filtration resistance of the filter (see page 6, [0075] last 7 lines); and

the negative pressure is caused by the memory of the valve (8) and by that liquid remained in a second side of the filter is sucked into a primary side of the filter (see [0045] and [0053]).

This does not make applicants' Claim 1 obvious under Section 103(a).

Applicants point out that Shiraishi et al. does not teach or suggest several matters and/or limitations in amended independent Claim 1.

The Office Action stated that Shiraishi et al. differs from the claim in that it is the resilient dispensing valve (8) and its associated connector sleeve (83) which causes the remaining liquid to be sucked into a primary side of the filter rather than the memory of inner layer (22) which is disclosed to be made of a synthetic resin made of a resilient material (see [0057] and [0060]). Shiraishi et al. also has different.

The Office Action stated that Meadows et al. teaches:

In Figs. 1 to 3 of a dispenser similar to that of applicants' and Shiraishi et al. to make an inner layer (inner bottle 30) from a resilient (compressible) material (LDPE) configured so as to create a "suck back" vacuum (see col. 4, lines 57 to 62; col. 6, lines 35 to 43).

The Office Action stated that it would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teachings of using the characteristics of the compressible inner bottle to suck back liquid into the inner layer of Meadows et al. in the dispenser of Shiraishi et al. because

doing so would allow the suck back function to be performed without the use of a resilient valve. Applicants disagree with this statement and disagree that one ordinarily skilled in the art would combine Shiraishi et al. and Meadows et al. in the quest for applicants' claimed invention.

The Office Action stated that further the application of the teachings of Meadows et al. to et al. Shiraishi et al. constitutes no more than combining prior art elements according to known methods to yield predictable results and the use of a known technique to improve similar device in the same way supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. \_\_\_, 82 USPQ2d 1385. Applicants' disagree with this statement – the KSR and the Graham decisions do not allow use of secondary considerations until the framework of the three primary factual inquiries have been factually determined in the record.

The Office Action stated, in reference to Claim 2, see Shiraishi et al. [0067]. Claim 2 has been cancelled and its content inserted into Claim 1. Accordingly, applicants have treated the rejection of amended independent hereunder.

Independent Claim 1 now recites that the filter is hydrophilic (from dependent Claim 2). Paragraph [0067], cited by the Examiner, of Shiraishi et al. states, in part: “....Though the filter 7 in this embodiment is a membrane filter, any filter, for example, a filter of sintered compact, a hydrophilic porous membrane or a hydrophobic porous membrane, prevents which predetermined kinds of microbes such as true fungi and bacteria from entering the container

from its downside (i.e., from outside) may be used.” This quoted portion of Shiraishi et al. state or indicate that its filters keep out air from inside of its containers.

Independent Claim 1 was also amended to recite that “the negative pressure is caused by the memory which expands the inner layer in a manner wherein a difference between an inner negative pressure and an ambient air is higher than a liquid filtration resistance of the filter and lower than an air filtration resistance of the filter wetted”.

Page 3, line 21, to page 2, line2, applicants’ specification states:

“The discharging container with a filter of the present invention is preferably formed wherein said filter has hydrophilicity. By that, the liquid inside is filled in the filter, so that it is possible to prevent the ambient air from entering the upper stream side of the filter without fail. Also, the elastic memory of the inner layer is preferably formed in a manner wherein the difference between the inner pressure of the inner layer and the ambient air is lower than the resistance, in which the air is able to pass through the filter filled with the liquid inside. That can prevent the air from entering in to the upper stearm of the filter more surely.” [Emphasis Supplied]

The above quoted disclosure from applicants’ specification sets support for the claim amendments any provides information why applicants’ claimed invention is unobvious over the rejection combination of Shiraishi et al. and Meadows et al.

In applicants' invention, when the hydrophilic filter gets wet, the liquid passes the filter comparatively easily. However, the air cannot pass the wet filter. The invention applies the characteristic of the above mentioned filter. As the air cannot the wet filter, the air is not inhaled from the filter internally. Applicants' advance that applicants' amended independent Claim 1 is unobvious and patentable.

The Office Action stated, in reference to Claim 3, see Shiraishi et al., Fig. 1. Applicants believe, as shown above, that amended independent Claim 1 is unobvious and patentable so dependent Claim 3 is patentable.

The Office Action stated: that, in reference to Claim 4, Shiraishi et al teaches to make the inner layer (22a,b) of a synthetic resin (plastic [0060]) as does Meadows et al. (low density polyethylene; col. 5; Il. 40 and 41); and that, however, the average thickness of the inner layer being over 0.35 mm is not taught.

The Office Action stated: that Meadows et al. does however explicitly teach:

"Wall thickness of the inner and outer bottles 30, 12 is of importance in the operation of the dispensing system 10. In this regard the wall thickness will, of course, depend not only on the surface tension of the formulation, but on bottle 30, 12 material, size and shape." (col. 5, Il. 30 to 34).

The Office Action stated: that, consequently, Meadows explicitly teaches that the inner layer wall thickness is an art recognized results effective variable to be selected based on the surface tension of the formulation, and on bottle 30, 12

material, size and shape; and that, thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to have selected the inner layer thickness to be over 0.35 mm through routine experimentation to optimize dispensing characteristics for a given formulation and bottle of selected material, size and shape as the optimization of an art known result effective variable would have been within the ordinary level of skill in the art as taught by Meadows. Applicants traverse this statement. The level of ordinary skill in the art has not been factually resolved in the record.

Withdrawal of this rejection is requested.

The Examiner is requested to call the undersigned attorney (at 301-469-5059) if he believes that Claim 1 should be amended, etc., in any particular way.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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Virgil M. Marsh

Virgil M. Marsh, Reg. No. 23,083

Fisher, Christen & Sabol  
1156 15<sup>th</sup> Street, N.W.,  
Suite 603  
Washington, D.C, 20005

Tel.: 202-659-2000  
Fax:: 202-659-2015